

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte Steven E. Armington, Richard O. Ratzel,
Paul J. Guth and MacDonald C. Booze

Appeal No. 2004-0116
Application No. 09/966,307

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 160 to 173 and 194 to 204, which are all of the claims pending in this application.¹

We REVERSE.

¹ Claim 160 was amended subsequent to the final rejection.

BACKGROUND

The appellants' invention relates to a cushioning conversion system which converts sheet stock material into cushioning material. More particularly, the present invention relates to a cushioning conversion system including a packaging controller, wherein the system is adapted to provide recommended packaging and/or packaging information to an operator based on the parts to be packaged, and further to provide for monitoring of packaging supply inventories (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

DePoint, Jr. et al. (DePoint)	5,105,600	Apr. 21, 1992
Simmons et al. (Simmons)	WO 95/13914	May 26, 1995
Advanced Logistics Systems, Inc.; OPTIPACK™ Computer Aided Carton Loader; 1996 (OPTIPACK™)		

Claims 160, 164, 165, 169 to 173 and 195 to 204 stand rejected under 35 U.S.C. § 103 as being unpatentable over DePoint.

Claims 161 to 164 and 194 stand rejected under 35 U.S.C. § 103 as being unpatentable over DePoint in view of Simmons.

Claims 166 to 168 stand rejected under 35 U.S.C. § 103 as being unpatentable over DePoint in view of OPTIPACK™.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 12, mailed January 10, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 11, filed November 25, 2002) and reply brief (Paper No. 13, filed March 17, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art (i.e., DePoint, Simmons and OPTIPACK™), and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain

the examiner's rejection of claims 160 to 173 and 194 to 204 under 35 U.S.C. § 103.

Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claim 160, the only independent claim on appeal, reads as follows:

A packaging system, comprising:
a packaging material supply device for supplying a packaging material;
a packaging system controller in communication with the packaging material supply device, the packaging system controller including a memory having packaging instructions related to at least one part to be packaged, the packaging instructions including at least one instruction for directing the packaging material supply device to provide packaging material for the at least one part to be packaged; and
an output device connected to the controller to provide at least one of an audible and a visual output of at least one of the packaging instructions in coordinated sequence with the at least one of the packaging instructions for directing the packaging material supply device.

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require an output device connected to the controller to provide at least one of an audible and a visual output of at least one of the packaging instructions in coordinated sequence with the at least one of the packaging instructions for directing the packaging material supply device. However, these limitations are not suggested by the applied prior art. In that regard, while it may have been obvious at the time the invention was made to a person of ordinary skill in the art to have provided DePoint's programmable controller 48, such as a general purpose computer, with output devices such as a video monitor and speakers, the applied prior art does not teach or suggest using any output device of a controller or computer to provide at least one of an audible and a visual output of at least one of the packaging instructions in coordinated sequence with the at least one of the packaging instructions for directing the packaging material supply device. To supply this omission in the teachings of the applied prior art, the examiner made a determination (answer, pages 4-5 and 7-8) that the differences would have been obvious to an artisan. However, this determination has not been supported by any evidence that would have led an artisan to arrive at the claimed invention. In that regard, Simmons and OPTIPACK™ do not supply that which we have indicated above to be lacking in the examiner's primary reference to DePoint.

In our view, the only suggestion for modifying DePoint in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure and not from the combined teachings of the applied prior art. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 160 to 173 and 194 to 204 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 160 to 173 and 194 to 204 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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